

specified date (line 30) if the user's network controller card is not capable of using the chronologically most recent update. Thus, the specification does discuss such a date, and therefore, withdrawal of the corresponding § 112 rejections of claims 41 and 43 is requested.

§ 103 Rejections of Claims 1-32 and 41-44:

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation in the prior art to support the combination of references. M.P.E.P. § 2143. Contrary to this requirement, the Examiner has provided no support for a suggestion or motivation for the combination of Apfel and Furner. In this manner, the Examiner provides no support from any of the cited references to support the § 103 combination. Thus, for at least this reason, the § 103 rejections of the claims are improper.

Furthermore, Apfel teaches away from the § 103 combination. In this manner, Apfel is not concerned whether the most recent software update is compatible with circuitry on Apfel's computer, as the update occurs regardless of whether the circuitry is compatible with the updated surface. Thus, Apfel teaches away from its combination with Furner. References cannot be combined where a reference teaches away from their combination. *In re Grasselli*, 713 F.2d, 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145X(D)(2). Thus, for at least this reason, withdrawal of the § 103 rejections of the claims is requested.

col 7:15-20

Additionally, Furner does not provide a suggestion or motivation for the § 103 combination. In this manner, Furner teaches determining compatibility to a particular program in response to the detection of new hardware, not in response to updating a particular software driver, for example. Thus, one skilled in the art would not have been motivated to apply Furner's teachings to Apfel. Therefore, for this additional reason, withdrawal of the § 103(a) rejections is requested.

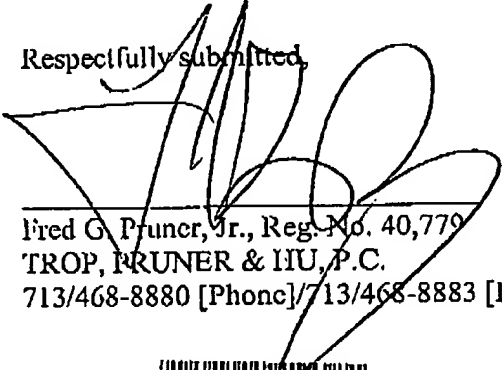
col 7:25-31

CONCLUSION

In view of the foregoing, withdrawal of the § 112 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (MCT.0088US).

Date: April 8, 2002

Respectfully submitted,

  
Fred G. Pruner, Jr., Reg. No. 40,779  
TROP, PRUNER & HU, P.C.  
713/468-8880 [Phone]/713/468-8883 [Fax]



21906

PATENT TRADEMARK OFFICE